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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,658	12/31/2003	Ki Hyup Kim	11037-175-999	1614
24341	7590 04/11/2006		EXAM	INER
MORGAN, LEWIS & BOCKIUS, LLP.			CECIL, TERRY K	
	TO SQUARE		ART UNIT	PAPER NUMBER
	3000 EL CAMINO REAL PALO ALTO, CA 94306		1723	
	•		DATE MAILED: 04/11/200	6

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)			
Office Action Summary	10/750,658	KIM, KI HYUP			
omce Action Gammary	Examiner	Art Unit			
The MAILING DATE of this communication and	Mr. Terry K. Cecil	1723			
The MAILING DATE of this communication app Period for Reply	ears on the cover sheet with the c	orrespondence address			
A SHORTENED STATUTORY PERIOD FOR REPLY THE MAILING DATE OF THIS COMMUNICATION.  - Extensions of time may be available under the provisions of 37 CFR 1.13 after SIX (6) MONTHS from the mailing date of this communication.  - If the period for reply specified above is less than thirty (30) days, a reply If NO period for reply is specified above, the maximum statutory period we Failure to reply within the set or extended period for reply will, by statute, Any reply received by the Office later than three months after the mailing earned patent term adjustment. See 37 CFR 1.704(b).	i6(a). In no event, however, may a reply be tim within the statutory minimum of thirty (30) days ill apply and will expire SIX (6) MONTHS from cause the application to become ABANDONE	ely filed s will be considered timely. the mailing date of this communication. O (35 U.S.C. § 133).			
Status	·				
1) Responsive to communication(s) filed on 04 No	ovember 2005.				
	action is non-final.				
3) Since this application is in condition for allowan					
closed in accordance with the practice under E	closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11, 453 O.G. 213.				
Disposition of Claims					
4)⊠ Claim(s) <u>1-8</u> is/are pending in the application.	•				
	4a) Of the above claim(s) is/are withdrawn from consideration.				
5) Claim(s) is/are allowed.					
· <u> </u>	☑ Claim(s) <u>1-8</u> is/are rejected.				
7) Claim(s) is/are objected to.					
8) Claim(s) are subject to restriction and/or	election requirement.	•			
Application Papers					
·					
9) The specification is objected to by the Examiner.					
10) ☐ The drawing(s) filed on 31 December 2003 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.					
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).					
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.					
	initier. Note the attached Office	Action 01:101111 F 10-152.			
Priority under 35 U.S.C. § 119					
12)⊠ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).					
a)⊠ All b)□ Some * c)□ None of:					
<ol> <li>Certified copies of the priority documents</li> </ol>	have been received.				
2. Certified copies of the priority documents have been received in Application No					
3. Copies of the certified copies of the priority documents have been received in this National Stage					
application from the International Bureau (PCT Rule 17.2(a)).					
* See the attached detailed Office action for a list of the certified copies not received.					
·		•			
Attachment(s)					
1) Notice of References Cited (PTO-892) . 4) Interview Summary (PTO-413)					
2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  Paper No(s)/Mail Date  5) Notice of Informal Patent Application (PTO-152)					
Paper No(s)/Mail Date three pages.  (PTO-1449 or PTO/SB/08)  Other:					

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#### **DETAILED ACTION**

## Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

- 2. Claims 6-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims are indefinite because of the following reasons:
- The following terms lack antecedent basis: "the hollow portion" (claim 6, lines 8-9).
- Claims 7-8 are rejected since they suffer the same defects as the claims from which they
  depend.

### Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

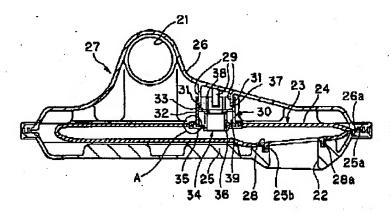
A person shall be entitled to a patent unless -

- (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
- (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
- (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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4. Claims 1-3 and 6-7 rejected under 35 U.S.C. 102(a) as being anticipated by the Japanese Reference JP2002-186807, hereinafter '807. '807 teaches an oil filter comprising a nonwoven



[0028] fabric filter 23 in the hollow space defined between upper and lower covers, each having a respective opening 21,22 for the flow of oil therethrough. A valve body (30,32,35) is integral with the

top cover [as in claims 1, 3 and 6] and includes a "gasket" (protrustion 31 fitting in recess 37) integral therewith [as in claims 2 and 6]. One of the covers can include a multitude of holes (see e.g. the top cover of figure 4 and the bottom cover of figure 6) [as in claims 2 and 7]. During the filtering process, oil entering opening 22 and flowing to the space enclosed by the filter 23 (specifically, oil flowing into the left side portion of the enclosed space in the figure above) necessarily flows "from the valve body and into the hollow portion" existing downstream of the filter 23 after being filtered.

#### Claim Rejections - 35 USC § 103

- 5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
  - (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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The factual inquiries set forth in *Graham* v. *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

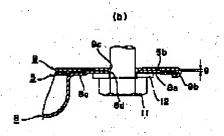
1. Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.

3. Resolving the level of ordinary skill in the pertinent art.

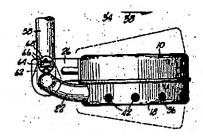
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over '807 in view of JP 2001-269514, hereinafter '514. '514 teaches an oil filter having first and second covers boltengaged to a valve body [0004, 0006, 0015]. It is considered that it would have been obvious



to one ordinarily skilled in the art at the time of the invention to have the bolt engagement of '514 in the invention of '807, since '514 teaches the benefit of preventing leaks in non-woven oil filters.

7. Claims 5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over '807 in view of '514 (claim 5) or in view of '807 (claim 8) and in further view of Dewey (U.S. 2,448,212). The claims have the limitation of at least three first oil holes with equal planar spacing. As shown in his figures, Dewey teaches at least three oil holes (42) that are equally spaced (a horizontal plane passing through the center of all the holes would have the holes equally-planarly spaced) [as in claims 5 and 8].



It is considered that it would have been obvious to one ordinarily skilled in the art at the time of the invention to have the at least three holes of Dewey in the invention of '807 (e.g. figure 4 thereof), since such would provide the benefit of still allowing a

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flow of oil if one or more of the inlet openings become clogged.

### 8. Contact Information:

- Examiner Mr. Terry K. Cecil can be reached at (571) 272-1138 at the Carlisle campus in Alexandria, Virginia for any inquiries concerning this communication or earlier communications from the examiner. Note that the examiner is on the increased flextime schedule but can normally be found in the office during the hours of 8:30a to 4:30p, on at least four days during the week M-F.
- Wanda Walker, the examiner's supervisor, can be reached at (571) 272-1151 if attempts to reach the examiner are unsuccessful.
- The Fax number for this art unit for official faxes is (571) 273-8300.
- Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mr. Terry K. Cecil Primary Examiner Art Unit 1723

TKC April 7, 2006